

Confirm. No. 7580
512425-2095**REMARKS**

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-9 are pending in this application. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE 35 U.S.C. 112, 1ST PARAGRAPH REJECTION HAS BEEN OVERCOME

Claims 1-10 were rejected as allegedly being only enabling for the substituents disclosed in the specification and failing to be enabled for all of the substituents encompassed by the claim recitations of "substituted".

Although the applicants disagree with the Examiner's position regarding this rejection, in order to advance prosecution, the term substituted has been deleted from the claims 1-6. The applicants reserve the right to further pursue this subject matter in a continuing application as there was no evidentiary support for the positions taken in the *Wands*-based analysis.

III. THE REJECTIONS UNDER 35 U.S.C. 102(e) HAS BEEN OVERCOME

Claim 10 was rejected as allegedly being anticipated by Boinowitz (U.S. Patent No. 6,552,091). Although the applicants disagree with the Examiner's position regarding this rejection, in order to advance prosecution, claim 10 has been cancelled which renders this rejection moot. The applicants reserve the right to further pursue the scope of claim 10 in a continuing application.

IV. THE DOUBLE PATENTING REJECTIONS HAVE BEEN OVERCOME

Claims 1-10 were rejected for double patenting as allegedly being obvious over Boinowitz, *ibid.* in view of Emmons et al. (U.S. Patent 4,155,892 - "Emmons").

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For an obviousness-type double patenting (ODP) the comparison of the applicants' claims is made only with respect to the claims of the reference cited, i.e. the specification of the Boinowitz reference cannot serve to assist the determination of obviousness. The question is whether the applicants' claims when compared against the claims of Boinowitz would have been obvious to one of ordinary skill in the art. They are not.

The basis for the ODP rejection appears to be the presence of the compound of formula (I) which also appears in the Boinowitz reference. However, the pending claims are not compound claims but composition claims which are comprised of different elements than that described by Boinowitz.

By way of example, the applicants compare in the table below the required elements of claim 1 and claim 7 from the present application against the required elements of claim 16 of Boinowitz (common elements in bold text):

Claim 1 of present application	Claim 16 of Boinowitz
A thickener comprising	
	A pigment paste, an aqueous , low-solvent or solvent-free coating material or a printing ink which comprises
polyurethanes	
	a pigment
water	
at least one viscosity regulator	from about 2 to about 200% of the low-foam pigment wetting agent as claimed in claim 14 , based upon the weight of the pigment.
Claim 7 of the present invention	Claim 16 of Boinowitz
An ink which comprises	A pigment paste, an aqueous , low-solvent or solvent-free coating material or a printing ink which comprises
a pigment	a pigment
and a thickener according to claim 1, i.e.	
polyurethanes	
water	
at least one viscosity regulator	from about 2 to about 200% of the low-foam pigment wetting agent as claimed in claim 14 , based upon the weight of the pigment.

As can be seen from the table above, the Boinowitz reference always is directed toward a composition which does not refer to a thickener and does not refer to the presence of a polyurethane. When restricted to this simple claim by claim comparison, it is clear that Boinowitz lacks all of the limitations of the applicants' claimed invention and there is no

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teaching or suggestion from within the claims which infers the inclusion of a polyurethane or a thickener.

The Examiner points to col. 4, lines 61-67 to implicate a teaching of polyurethanes from Boinowitz. However, this is incongruous with *the claimed invention of Boinowitz*. This passage reads as follows:

"Suitable coating systems in which the pigment pastes of the invention may be incorporated are any desired aqueous one- or two-component (1K or 2K) coating materials, and also nonpolar low-solvent or solvent-free coating systems. Examples that may be mentioned include aqueous 1K coating materials, such as those based on alkyd, acrylate, epoxy, polyvinyl acetate, polyester, or polyurethane resins, or aqueous 2K coating materials, examples being those based on hydroxyl-containing polyacrylate or polyester resins with melamine resins or blocked or unblocked polyisocyanate resins as crosslinkers. Mention may also be made of polyepoxy systems. Low-solvent coating materials that may be mentioned include, in particular, those based on long-oil alkyd oils."

Polyurethanes are mentioned only in the context of a suitable coating system, *not the pigment paste itself*. Such that the specification can be used at all for determinations of ODP, it may only be used to interpret the meaning of the terms of the claims. By definition, the pigment paste clearly does not include a polyurethane. When restricted to the claim vs. claim analysis of ODP, all of the claimed limitations are not taught or suggested.

Therefore, the claims are unobvious under narrower obviousness standard of obviousness-type double patenting (and would have been unobvious under the broader standard of obviousness under 35 U.S.C. 103(a) because even the "suitable coating" system is not suggestive of the thickener compositions of the invention) and the rejection can properly be withdrawn.

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512425-2095CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
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